

### REMARKS

In the Office Action, claims 38-43, 45-49 and 52-60 were rejected. More specifically, Claims 38-43, 45-49 and 52-60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,222,722 to Fukuzumi et al. in view of U.S. Patent No. 6,077,742 to Chen et al. in further view of U.S. Patent No. 6,165,834 to Agarwal et al. For the reasons set forth hereinbelow, Applicants request that the 35 U.S.C. § 103(a) rejections associated with the pending claims be withdrawn.

Claims 38-43, 45-49 and 52-60 are additionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 81-112 of U.S. Application Serial No. 10/172,253; claims 81-113 of U.S. Application Serial No. 10/299,145, claims 81-109 of U.S. Application Serial No. 10/299,752; and claims 81-108 of U.S. Application Serial No. 10/299,728. Applicants acknowledge the provisional double patenting rejections and respectfully request that the provisional double patenting rejections be held in abeyance until the 35 U.S.C. § 103(a) rejections have been withdrawn.

By this amendment, claims 38, 52 and 58 have been amended. Thus, claims 38-43, 45-49 and 52-60 are pending.

### Agarwal Reference

Applicants submit that the Agarwal reference cannot be used to preclude the patentability of the present application under 35 U.S.C. § 103 because it, in conjunction with the present application, meets the requirements of 35 U.S.C. § 103(c), which provides that:

- (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants submit that the Agarwal reference, filed on May 7, 1998 and issued on December 26, 2000, is prior art relative to the current application only under 35 U.S.C. § 102(e). Also, Applicants submit that the present application and the Agarwal reference were, at the time the present invention was made, owned by, or subject to an obligation of assignment to, the same person, Micron Technology, Inc. of Boise, ID. Therefore, Applicants request that the rejections over the Agarwal reference be withdrawn.

#### Section 103 Rejections

Applicants have herein amended independent claim 38 to recite, “heating the dielectric in the presence of an oxygen-containing ambient.” Applicants traverse the rejection of claim 38 as being unpatentable over Fukuzumi in view of Chen and Agarwal.

One of the elements of a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is that the cited reference, or references when combined, must teach or suggest all of the claim limitations. *See* MPEP § 2142. For purposes of various arguments presented herein, Applicants invite attention to MPEP §2142, which reads, in pertinent part, as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(emphasis added).

Applicants further invite attention to MPEP §2143.03, which is entitled "All Claim Limitations Must Be Taught or Suggested" and which reads, in pertinent part, as follows:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

(emphasis added).

At least for the reasons provided below, the cited references, alone or in combination, fail to teach or suggest all of the elements of the claims of the present application. As amended, claim 38 recites, "heating the dielectric in the presence of an oxygen-containing ambient." As such, any combination of references cited against claim 38 must teach or suggest this feature, which is not the case here.

Applicants submit that Fukuzumi fails to teach or suggest at least the above feature of amended claim 38. In fact, Fukuzumi is silent about subjecting a dielectric to a heating step, let alone, "heating the dielectric in the presence of an oxygen-containing ambient," as recited in amended claim 38.

Applicants also submit that Chen fails to teach at least the above feature of amended claim 38. Like Fukuzumi, Chen is silent about any step involving heating a dielectric, let alone, "heating the dielectric in the presence of an oxygen-containing ambient," as recited in amended claim 38.

Therefore, Applicants submit that claim 38 and claims 39-43 and 45-49, which depend directly or indirectly from claim 38, are allowable over the cited references. *See* MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (“If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.”))

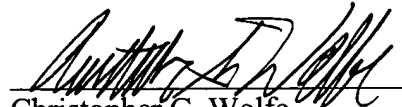
Applicants submit that independent claims 52 and 58 have also been amended similarly to claim 38. Therefore, Applicants submit that claims 52 and 58 as well as claims 53-57 and 59-60, which depend directly or indirectly therefrom, are allowable over the cited references for the same reasons discussed above with reference to claim 38.

Applicants are not otherwise conceding, however, the correctness of the Office’s rejections with respect to any of the dependent claims discussed above and hereby reserve the right to make additional arguments as may be necessary because the dependent claims include additional features that further distinguish the claims from the cited references, taken alone or in combination. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

CONCLUSION

Applicants respectfully request a Notice of Allowance for the pending claims in the present application. If the Examiner is of the opinion that the present application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,

  
Christopher G. Wolfe  
Reg. No. 56264

KIRKPATRICK & LOCKHART, NICHOLSON, GRAHAM, LLP  
Henry W. Oliver Building  
535 Smithfield Street  
Pittsburgh, Pennsylvania 15222

Telephone: (412) 355-8244  
Facsimile: (412) 355-6798  
E-mail: [cwolfe@kl.com](mailto:cwolfe@kl.com)

Customer No. 26285